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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,058	07/31/2003	Andrew J. Ries	P-11122.00	9970

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MEDTRONIC, INC.
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EXAMINER

ALTER, ALYSSA M

ART UNIT PAPER NUMBER

3762

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,058

Applicant(s)

RIES ET AL.

Examiner

Alyssa M Alter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/06/03 & 1/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/632028 (US Patent Publication 20050027326 A1).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both have a connector assembly for detachably connecting a lead to an implantable medical device, comprising a deflectable connector clip including a first arm, a second arm, the connector clip capable of being deflected from a first position corresponding to a first relative position of the first arm and the second arm to a second position corresponding to a second relative position of the first arm and the second arm; and a housing having a first member and a second member, the first member formed to be fixedly engaged with the second member to enclose the

connector clip within the housing, wherein the connector clip is positioned within one of the first member and the second member.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. 10/632026 (US Patent Publication 20050027325 A1).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both have a connector assembly for detachably connecting a lead to an implantable medical device, comprising a deflectable connector clip including a first arm, a second arm, the connector clip capable of being deflected from a first position corresponding to a first relative position of the first arm and the second arm to a second position corresponding to a second relative position of the first arm and the second arm; and a housing having a first member and a second member, the first member formed to be fixedly engaged with the second member to enclose the connector clip within the housing, wherein the connector clip is positioned within one of the first member and the second member.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 5-7, 13, 15-17, 19-21 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lim (US 5,769,671). Lim discloses a connector spring is radially deflectable and used to compress and engage two axially orientated electrical conductors together. "The spring is a metallic member having a general square shape as defined by four opposed sides each connected by a corner portion interposed therebetween and facing the central axis, and the spring on each side thereof having deformed portions which extend inwardly beyond the respective side face thereof and toward the central axis"(col. 2. lines 34-39). In figure 5, the examiner considers the contact spring to be a clip with 23b as the first arm, 23d as the second arm and 23c as the top portion. Since the spring is a metallic spring used to enhance electrical contact, the examiner considers it to be inherently electrically conductive.

"The connector more specifically comprises an elongated housing extending along a central axis, the housing has a generally cylindrical opening extending coaxially with the central axis. The opening in the housing is defined by first and second cylindrical surfaces each defined by a first diameter. An annular radially directed gap is disposed within the opening and is disposed axially between the first and second cylindrical surfaces, with the annular gap extending radially outwardly from the axis and beyond each of the first and second cylindrical surfaces. The gap has a given width as measured along the axis extending in the direction parallel thereto. A contact spring is provided and has a generally closed shape and is of a width sufficient to be received

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within the gap and has portions thereof extending inwardly toward the axis and into the opening”(col. 2, lines 12-26). “The opening 10 in the housing 4 has an interrupted inner surface as defined by concentric first and second axially spaced cylindrical inner surfaces 12 and 14, respectively, together defining an annular radially directed gap 16 therebetween”(col. 3, lines 21-25).

“The annular gap in the housing is defined by an annular shoulder formed in the inner surface of the housing, the shoulder defines one of the first and second surfaces of the first diameter and defining a stepped annular surface of a second diameter wider than the opening and a collar member received within the second diameter in abutment against the spring”. The examiner considers the shoulder to be a support ridge, more specifically, a flange, which is a “rib or rim for strength” according to Merriam-Webster {see Reference U}.

As to the first, second and third positions and distances of the clip, “The sheet metal forming this spring 2 has a thickness of about 0.003 inches and is a generally closed shape member defined by opposed free ends 31 and 33, which in the relaxed condition, define a gap referenced in FIG. 5 as 29. In the assembled condition of the connector and before the lead is introduced into the opening 10, the free ends of the spring maintain a spacing of approximately 0.005 inch”(col. 4, lines 27-33). Lim discloses that the gap 29 is approximately 0.005 inch when placed in the housing, before the introduction of a lead. Therefore, the second position is at a distance of approximately 0.005 inch and a third position is at a larger distance after the insertion of a lead. The third position will inherently create a larger gap since that will enable the

spring to compress the lead. As to a first position, the examiner considers the relax condition of the spring to be the first position.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 4, 8-12, 14, 18, 22-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim (US 5,769,671). Lim discloses the claimed invention but does not disclose expressly the stainless steel or tapered portions of the arms. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the metallic material and arms as taught by Lim, with the stainless steel and tapered arms, because Applicant has not disclosed the stainless steel or tapered arms provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected the Applicant's invention to perform equally well with the metallic material and uniform diameter arms as taught by Lim, because the spring could still be conductive and the arms would still deform to compress and secure the lead.

Therefore, it would have been an obvious matter of design choice to modify metallic material and arms to obtain the invention as specified in the claim(s).

Also, Lim discloses the claimed invention except for two clips. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create two springs, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In addition, Lim discloses the use of a spring disposed in a square shape, which is the same structure that the Applicant creates with two U-shaped clips. It would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to modify the continuous square into two separate structures in order to provide a secondary means of support in the event that the spring is defective.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 144, 131, 129 and 125. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The

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objection to the drawings will not be held in abeyance. The examiner recommends changing the reference numbers to 44,31,29 and 25.

2 The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 44,31,29 and 25. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

1. The disclosure is objected to because of the following informalities: the reference character 11 is used to describe both the deflect spring arms and the positioning screws. The examiner recommends changing one of these components to a different number. Appropriate correction is required.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

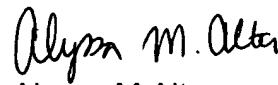

1. Crawford (US 4,848,346) discloses a pacemaker connector system.
2. Cowdery et al. (US 4,445,511) discloses a pacer electrode connector assembly.
3. Biggs et al. (US Patent Publication 20040093038 A1) discloses one piece header assembly for an implantable medical device.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M Alter whose telephone number is (571) 272-4939. The examiner can normally be reached on M-F 9am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alyssa M Alter
Examiner
Art Unit 3762



JEFFREY R. JASTRZAB
PRIMARY EXAMINER
5/16/05